

### **REMARKS**

The claims have not been amended. Accordingly, claims 1, 8, 15, 17, 19, 21, 23, and 25 are currently pending in the application, of which claims 1, 8, 15, and 17 are independent. Applicants appreciate the indication that claims 1, 8, 19, and 21 are allowed.

Applicants request reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

#### ***Rejections Under 35 U.S.C. § 103***

To establish an obviousness rejection under 35 U.S.C. § 103(a), four factual inquiries must be examined. The four factual inquiries include (a) determining the scope and contents of the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966). In view of these four factors, the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007). Furthermore, even if the prior art may be combined, the combination must disclose or suggest all of the claim limitations. *See in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 15 and 23 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2003/0054863 applied for by Lee, *et al.* ("Lee") in view of U.S. Patent Application Publication No. 2004/0067751 applied for by Vandermeijden, *et al.* ("Vandermeijden"). Applicants respectfully traverse this rejection for at least the following reasons.

Even if the cited references could be combined, they fail to disclose every feature of claim 15. The examiner concedes that Lee fails to disclose every feature of claim 15, and looks to Vandermeijden to remedy Lee's shortcomings by disclosing "wherein the caller information received at the RF receiver is automatically updated in the mobile terminal by linking an updated image or updated telephone number contained in the data with a preexisting telephone number stored in a telephone directory." Office Action, page 3. Applicants respectfully disagree.

Specifically, Vandermeijden falls short in remedying Lee's shortcomings because according to claim 15, the automatic updating occurs "by linking an updated image or updated telephone number contained in the data with a preexisting telephone number stored in a telephone directory." (emphasis added). Although Vandermeijden describes generally updating a local contact database 24 at paragraph [0051], Vandermeijden clarifies in paragraph [0052] that the updating is limited to adding "name and address information ... to a contact database in a wireless handset, based on Caller-ID information in either an incoming or an outgoing telephone call." Further, Vandermeijden discloses that if the contact database 24 already includes a telephone number and data associated with that number, "the process ends." Vandermeijden, paragraph [0054]. Alternatively, if the contact database 24 does not include a new telephone number, such as an updated telephone not in the contact database 24, "the browser 22 adds the telephone number of the incoming or outgoing call to the contact database 24." Vandermeijden, paragraph [0054]. Thus, upon receiving an unrecognized telephone number, even for a person already stored in the contact database 24, Vandermeijden would simply create a new entry.

Vandermeijden does not disclose, however, that the pre-stored entry in the contact database 24 is updated with "an updated image or updated telephone number."

For at least these reasons, Vandermeijden fails to disclose at least "wherein the caller information received at the RF receiver is automatically updated in the mobile terminal by linking

an updated image or updated telephone number contained in the data with a preexisting telephone number stored in a telephone directory.”

Further, for at least these reasons, Lee in view of Vandermeijden fails to disclose every feature of claim 15.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 15. Claim 23 depends from claim 15 and is allowable at least for this reason. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claim 15, and all the claims that depend therefrom, are allowable.

Claims 17 and 25 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee in view of U.S. Statutory Invention Registration No. H1714 filed by Partridge, III (“Partridge”). Applicants respectfully traverse this rejection for at least the following reasons.

Even if the cited references could be combined, they fail to disclose every feature of claim 17. The examiner concedes that Lee fails to disclose every feature of claim 17, and looks to Partridge to remedy Lee’s shortcomings. However, neither Lee nor Partridge, alone or in combination, discloses “wherein the service system stores the data as a data packet until the receiving party can receive the caller information.” (emphasis added).

The examiner suggests that Partridge’s col. 6, lines 19-25, which discloses that the “image may be translated or reformatted so as to be compatible with the particular transmission media being employed at the time,” inherently discloses this feature of claim 17. But where the examiner relies upon the theory of inherency, the examiner is required to provide extrinsic evidence that the features are necessarily present in the reference. As noted in MPEP § 2112, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not

sufficient to establish the inherency of that result or characteristic.” (emphasis in original).  
Rather, when “relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (citation omitted) (emphasis in original). Since the examiner has not provided evidence that data packets are inherently disclosed among the transmission media, particularly in view of Partridge’s 1995 filing date, the examiner has not provided sufficient evidence to rely on Partridge inherently disclosing such features as set forth in the Office Action.

For at least these reasons, the rejection of claim 17 over Lee in view of Partridge cannot be maintained.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 17. Claim 25 depends from claim 17 and is allowable at least for this reason. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claim 17, and all the claims that depend therefrom, are allowable.

***Allowable Subject Matter***

Applicants appreciate the indication that claims 1, 8, 19, and 21 are in condition for allowance.

**CONCLUSION**

A full and complete response has been made to the pending Office Action and all of the stated grounds for rejection have been overcome or rendered moot. Accordingly, all pending claims are allowable and the application is in condition for allowance.

The Examiner is invited to contact Applicants' undersigned representative at the number below if it would expedite prosecution. Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

/hae-chan park/

Hae-Chan Park  
Reg. No. 50,114

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**CUSTOMER NUMBER: 58027**  
H.C. Park & Associates, PLC  
8500 Leesburg Pike  
Suite 7500  
Vienna, VA 22182  
Tel: 703-288-5105  
Fax: 703-288-5139  
HCP/WMH/ebs